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EXAMINER
SOREY, ROBERT A

ART UNIT	PAPER NUMBER
3626	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Advisory Action

Continuation of 11. does NOT place the application in condition of allowance because:

Firstly, Applicant's amendments do not further limit the invention. The amendments overcome the 35 U.S.C. 112, first and second paragraph, rejections concerning the written description and indefiniteness of the rejected claims. The 35 U.S.C. 112 rejections are withdrawn in view of Applicant's corrective amendments.

Secondly, Applicant argues that "the Office Action relies on a combination of five references… This many references are needed because no single reference is capable of outlining the claimed invention well enough for the person of skill in the art to use it to fill in the missing pieces. Applicants respectfully submit that the rejection is piecemeal and that one of ordinary skill in the art would not have been reasonably able to sift through the entire specification of each of these references, pick out the bits and pieces of the newly cited references Anderson and Patel, and Christenson and combine them with De La Huerga and Bocioned to arrive at the present claims".

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, the cited references reasonably pertain to the particular problem with which Applicant is concerned and were correctly combined using KSR rationale, as per MPEP 2141 (III), to meet the claimed invention.

Applicant further characterizes the cited references as being directed toward a field of endeavor not analogous to Applicant's invention. For example, Applicant states that Christensen is directed to an “educational institution”, Anderson is directed to processing “invoice information”, and Patel is generally directed to a “transportation network”. Specifically, Applicant states: “[A] reference under 35 U.S.C. §103(a), it must be analogous prior art. (See MPEP 2141.01(a)). "Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent [or application at issue] can provide a reason for combining the elements in the manner claimed." KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1397 (2007) (emphasis added). Thus a reference in a field different from that of applicant's endeavor may only be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole. Christensen is directed to a method and system of integrating databases for an educational institution, Anderson relates to a billing/invoicing network and Pate1 relates to a ground transportation network. None of these references are in the medical field (the field of endeavor of Applicants' invention).

One of ordinary skill in the art at the time of the invention evaluating the best way to accommodate validated and non-validated information in a medical information system would have had no reason to look to the above non-analogous references. Applicants' field of endeavor is specific to an FDA-compliant medical system".

The Examiner respectfully disagrees. Applicant's arguments are not persuasive. In response to applicant's argument that Christensen, Anderson, and Patel references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Christensen, Anderson, and Patel were not used to teach the limitations concerning medical information. Christensen was cited to teach a first and second database that are able to work in a coordinated manner in which the second database reflects or contains the same information as the first database – this meets Applicant's limitation concerning a first database that is a subset of a second database. Christensen and the limitation it addresses concerns databases and in that respect Christensen is directed toward Applicant's invention and is analogous. Similarly, Anderson was cited to teach synchronization of the databases occurs at designated time intervals (i.e., a periodic basis). Anderson and the limitation it addresses concerns databases and in that respect Anderson is directed toward Applicant's invention and is analogous. Similarly, Patel was cited to teach synchronizing databases immediately and automatically with any change in information. Patel and the

limitation it addresses concerns databases and in that respect Patel is directed toward Applicant's invention and is analogous.

It should also be noted that these limitations are old and well known features of database operations. The reason they are not found in a single reference that also addresses "FDA-compliant medical system[s]" is because the features recited have little to do with medical systems and are obvious features of computer and database systems.

Finally, Applicant states that the field of endeavor of Applicant's invention is specific to an "FDA-compliant medical system", however, there appears to be no mention of the FDA or compliance procedures in the claims.

Furthermore, as previously stated, the cited references reasonably pertain to the particular problem with which Applicant is concerned and were correctly combined using KSR rationale, as per MPEP 2141 (III), to meet the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT SOREY whose telephone number is (571) 270-3606. The examiner can normally be reached on Monday through Friday, 8:30AM to 5:00PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Morgan can be reached on (571) 272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. S./
Examiner, Art Unit 3626

/Robert Morgan/
Supervisory Patent Examiner, Art Unit 3626